

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 2006

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated March 22, 2006. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

The specification is amended herein to correct an obvious typographic error. No new matter is added by this amendment to the specification and entrance thereof is respectfully requested.

Claims 1-7 were pending in this application. Claims 2 and 3 are canceled herein, without prejudice. The Applicant reserves the right to reintroduce subject matter deleted herein, either at a later time during the prosecution of this application or any continuing applications. Claim 8 is added by this amendment. By means of the present amendment, the claims have been amended for better conformance to U.S. practice, such as changing "characterized" to --wherein--, as well as deleting reference numerals typically used in European practice that are known to not limit the scope of the claims.

In the Office Action, Claims 1, 2, 5-7 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No.

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 206

6,240,240 to Nagano ("Nagano"). Claims 3 and 4 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Nagano.

These rejections are respectfully traversed.

The Office Action rejects Claims 3 and 4 as being unpatentable over Nagano in view of Official Notice that priorities are automatically initialized according to the sequence in which the programs are added to the list. An example is provided where it is stated that "priorities may be supplied by the user or assigned by the apparatus based on a user profile ..." (See, Office Action, page 4, numbered paragraph 4, last full sentence.)

While the truth of that above statement is neither accepted nor disputed at this time, it is not clear what this has to do with the claim limitation of original claim 3, now claim 1? A similar position of taking Official for elements not shown in Nagano is taken with regard to the rejection of Claim 4.

The MPEP in §2144.03 in a section titled "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art" makes clear that only in limited circumstances is it appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection and that such rejections should be judiciously applied.

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 206

MPEP in §2144.03(A) is entitled "Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion". Therein it states that (emphasis provided) "Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)) ... Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 206

noticed are of notorious character and serve only to 'fill in the gaps' which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); Ahlert, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21 ... In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ('[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.').

It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the

Patent
Serial No. 09/992,921

Amendment in Reply to Office Action of March 22, 2006

principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ... As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697. See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) ... "The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."

Accordingly, the Applicants respectfully traverse the Office Actions taking of Official Notice for the elements of original claim 3 (now claim 1) and claim 4. It is respectfully requested that the Examiner produce such a reference so that the Applicant may review and refute these assertions.

Accordingly, it is respectfully submitted that Claims 1 and 4 are allowable over Nagano and an indication to that effect is respectfully requested.

New Claim 8 requires (emphasis added) "repeating steps (a) and (b) until the list is complete wherein a priority is assigned to some or all of the programs on the list, and programs or parts of programs overlapping in time are processed according to their

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 2006

priorities and wherein programs that are overlapping in time that have different priorities are visually represented as a higher priority program overlapping a lower priority program" and accordingly is also allowable over Nagano since Nagano does not show visually overlapping programs (e.g., see, FIGs. 15A, 15B, 16A-16C).

Based on the foregoing, the Applicant respectfully submits that independent Claims 1, 4 and 8 are patentable over Nagano and notice to this effect is earnestly solicited. Claims 5-7 respectively depend from Claim 1 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of said claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicant reserves the right to submit further arguments in support of the above stated position,

Patent
Serial No. 09/992,921
Amendment in Reply to Office Action of March 22, 206

should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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